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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,284	10/11/2000	Andrea C. Hughs-Baird	0112300/143	5144

29159 7590 04/25/2002

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EXAMINER
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ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 04/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/686,284

Applicant(s)

HUGHS-BAIRD, ANDREA C.

Examiner

Steven Ashburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.


## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

  
MARK SAGER  
PRIMARY EXAMINER

Art Unit: 3714

## ***DETAILED ACTION***

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claims:

- a. A selection confirmation indicator connected the processor enabling the player to confirm selections after the player selects all of his selections. See e.g. claim 16.
- b. A selection confirmation indicator connected the processor enabling the player to confirm each selection after the player selects all of his selections. See e.g. claim 17.
- c. Operating the game through a data network. See e.g. claims 33 and 34.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The amendment filed 06 February 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claims 17 and 19 state, "a selection confirmation indicator connected to the processor which enables the player to confirm each selection picked by the player." In comparison, the original disclosure states, "... in the preferred embodiment, the player chooses all of the symbols and then presses a selection confirmation button to reveal the symbols." Thus the amendment introduces new matter. Applicant is required to cancel the new matter in the reply to this Office Action.

Art Unit: 3714

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 19 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims state, “a selection confirmation indicator connected to the processor which enables the player to confirm each selection picked by the player.” In comparison, the specification states, “... in the preferred embodiment, the player chooses all of the symbols and then presses a selection confirmation button to reveal the symbols.” Thus, the specification describes a player indication that initiates the bonus game process after the player has made all selections. This does not support the language of claim 17 that describes confirming each selection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by ‘Tic-Tac-Dough’, <[www.angelfire.com/wrestling3/jay\\_anton/tictackpages/-tictacdough.html](http://www.angelfire.com/wrestling3/jay_anton/tictackpages/-tictacdough.html)> (describing the television game show TICK-TAC-DOUGH® by Jack Barry and Dan Enright Productions, a division of Sony Pictures Entertainment airing from 1978-1986) (hereinafter “Tic-Tac-Dough”).

Art Unit: 3714

Claims 27-29 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas, U.S. 6,322,309 (Nov. 27, 2001).

Thomas teaches all the features of the claims including a plurality of selections associated with symbols provided to a player on a display; allowing the player to make a number of picks from the display; crediting player an amount associated with each pick having an associated credit symbol; accumulating the award symbols from each pick having an associated award symbol; and providing the player an award based on the number of accumulated award symbols wherein the award increases non-linearly as the number of accumulated award symbols increases. See fig. 8; col. 9:55-11:65.

More specifically, the applicant claims define the invention as providing a player an additional award based on the number of accumulated award symbols wherein the additional award non-linearly increase as the number of accumulated award symbols increases. Thomas discloses a selection-type bonus game based on the MONOPOLY™ board game. See col. 11:19-65. The game includes sets of collectable award symbols, each having an associated value. A player is awarded for each selection of an award symbol *and* for completing sets of award symbols. See *id.* For example, a set of two related award symbols might consist of symbols 'B' and 'P' with values of 50 and 40 coins respectively. See *id.* A player would be awarded the value of each selection and an additionally award of 90 (i.e. 50 +40) for completing the set. Similarly, a set of award symbols 'C', 'V' and 'O' with values of 10, 10, and 12 coins respectively would be awarded the base value when each is selected and the sum of 32 coins when the set is completed. Hence, Thomas pays an additional award that increases non-linearly based on the different numbers and values of award symbols contained in a set. Thus Thomas teaches a gaming device having claimed structure and method of operating a device performing the same steps.

Art Unit: 3714

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8, 9-11, 15 20, 23, 30, 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, U.S. 6,322,309 (Nov. 27, 2001) in view of Tic-Tac-Dough.

Thomas discloses all the features of the claimed subject matter except a jackpot award associated with award symbols. Regardless of this deficiency, the above features are known and would be obvious to one of ordinary skill in the art.

Tic-Tac-Dough describes an analogous gaming device having a selection-type bonus game wherein a player makes a number of picks from a display containing an array of selections. Selections include credit symbols, award symbols and functional symbols. The award symbols are labeled 'Tic' and 'Tac'. See pp. 6-7. If the player accumulates both award symbols, he is paid a jackpot. Thus, Tic-Tac-Dough describes the claimed feature of a jackpot award associated with accumulated award symbols.

It would have been obvious to one skilled in the art at the time of the invention to add the jackpot feature of Tic-Tac-Dough to Thomas. It is notoriously well known in the art to adapt television game shows into gaming devices. Gaming devices based on television game show themes provide several advantages. First, they allow operators to take advantage of a show's well popular name and rules in order to attract more players and thereby increase revenue. Second, they offer game show fans easy access to a game without the difficulty of becoming one of a few studio contestants. Third, they offer players who prefer to participate individually the opportunity to participate by themselves. Finally, they allow television game show owners to reach a large number of players and thereby generate greater royalties. Thus, it would have been obvious to an artisan at the time of the invention to adapt Tic-Tac-

Art Unit: 3714

Dough for use in gaming devices. In view of Tic-Tac-Dough, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device in Thomas to incorporate the features of awarding a jackpot based on the player's accumulations of bonus award symbols in order to enhance player interest in the game by offering a jackpot award. As a result, the combined system would provide a gaming device with a bonus game that would heighten player usage due to larger potential awards and thereby increase operator revenue there from.

Claims 3, 4, 12, 13, 21, 22, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the either Thomas, or the combination of Thomas and Tic-Tac-Dough, in further view of Mayerhoff, U.S. 6,231,442 (May 15, 2001)

The combination of references is described above. Each represents a variation of a selection-type bonus game. The combinations disclose all the features of their respective claims except (1) means for determining the number of selections in the bonus game based on player's wager in the primary game; and (2) providing a sufficient number of selections to allow the player to select award symbols necessary for obtaining a winning combination. Regardless of these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Mayerhoff discloses a gaming device with an analogous selection-type bonus scheme. The number of selections in the bonus game is based on the player's wager in the primary game. See col. 7:47-52. Mayerhoff suggests that this method motivates players to increase their primary wagers. See col. 3:57-60. Thus, Mayerhoff discloses the feature of claims 3, 12, 21, and 31. It is implicit within the disclosure that number of selections provided is sufficient to allow a player to win in the secondary game. Thus, Mayerhoff suggests the features of claims 4, 13, 22, and 32 to one of ordinary skill in art.

In view of Mayerhoff, it would have been obvious to one skilled in the art at the time of the invention to combine the feature of basing the number of selections in the bonus on the player's wager in the primary game with the selection-games described by Thomas, or the combination of Thomas and Tic-

Art Unit: 3714

Tac-Dough in order to motivate players to increase their wagers to gain more selections to receive greater odds of a bonus payoff and thereby increase operator revenue from the increased wagers.

Claims 6, 7, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Tic-Tac-Dough or the combination of Thomas with Tic-Tac-Dough, both in further view of Faciglia, U.S. 5,647,798 (Jul. 15, 1997).

The rejections of the claims by Tic-Tac-Dough or the combination of Thomas with Tic-Tac-Dough is discussed above. Each represents a variation of a selection-type bonus game. The references describe all the features of their respective claims except (1) functional symbols that change the total number of selections and (2) functional symbols that modify the number of credits provided to the player. Regardless of these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Faciglia discloses an analogous gaming device wherein player attempts to complete a winning pattern displayed on a matrix. See fig. 1, 2. The player completes a pattern by matching random game outcomes with selections in the game matrix. See id. The outcome symbols include numbers corresponding to selections in the matrix and functional symbols that The player accumulates credits for each outcome matching a selection displayed in the matrix. See col. 5:45-49. Each functional symbol serves a different "special" function intended enhancing the game. See col. 3:35-52. In once case, the player may accumulate "free spin" symbols that allow the player to make additional attempts. See col. 5:12-19. In another, the player may receive a "Gold Star" that allow the player additional winnings. See col. 3:33-52. In yet another, a special outcome might include a "Devil" symbol that causes the player to lose his accumulated winnings. See id. In regards to the claims, Faciglia teaches the claimed features of providing functional symbols changing the total number of attempts or modifying the number of credits paid to the player.



Art Unit: 3714

In view of Faciglia, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tic-Tac-Dough or the combination of Thomas with Tic-Tac-Dough to add symbols that change the number of selections and award modified the payouts to heighten player's interest in a game in order to increase the game's popularity game and thereby increase operator revenue. See col. 3:33-52.

Claims 16, 17, 18, 19, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Tic-Tac-Dough or the combination of Thomas with Tic-Tac-Dough or the combination of Thomas with Tic-Tac-Dough and Mayeroff; all in further view of Holmes, U.S. 5,882,259 (Mar. 16, 1999).

The references above disclose all the features of their respective claims except (1) a selection confirmation indicator enabling the player to confirm the player's selections after the player selects all of the player's selections and (2) a selection confirmation indicator enabling the player to confirm each selection picked by the player. Regardless these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Holmes discloses an analogous gaming device where a player selects a set of choice from a matrix a available choices. In particular, a matrix of all possible selections is displayed to the player. See fig. 3; col. 2:38-3:5. The player selects a predetermined number of choices and presses "play" to initiate the game after the player has confirmed his choices. See id. Subsequently, the player is paid for receiving cards or combinations that match his selections. See id. Thus, Holmes discloses the claimed features.

It would have been obvious to one skilled in the art at the time of the invention to add the confirmation feature disclosed in Holmes to the selection games of Tic-Tac-Dough or the combination of Thomas with Tic-Tac-Dough or the combination of Thomas with Tic-Tac-Dough and Mayeroff. Each of the prior combinations is a variant a selection-type game where a player picks selections one at a time from a matrix and receives an outcome instantly. One of ordinary skill in the art would also be familiar

Application/Control Number: 09/686,284

Art Unit: 3714

with games where a player first picks all selections prior to receiving a gaming result. Such systems are commonly seen, for example, in video keno devices. Holmes discloses a video poker device that incorporates this feature of picking an entire set of selections from a display and then displaying a game outcome after the player confirms his selections. See fig. 3. An artisan of ordinary skill at the time of the invention would have knowledge of single selection games where selections are made individually (e.g. Thomas) or, where selections are made as a group (e.g. Holmes). Thus, it would have been a matter of design choice to employ either method. In view of Holmes, it would be obvious to provide a selection confirmation indicator enabling the player to confirm the player's selections after the player selects all of the player's selections to provide a player a greater sense of control over the game outcome. The addition would heighten player's interest in a game in order to increase the game's popularity game and thereby increase operator revenue.

Claims 33, 34, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Thomas or the combination of Thomas with Tic-Tac-Dough, both in further view of Walker, U.S. 6,001,016 (Dec. 12, 1999).

The references above disclose all the features of their respective claims except operating the game through a network or Internet. Regardless these deficiencies, the above features are known and would be obvious to one of ordinary skill in view of prior art.

Walker discloses a system for remote gaming over a network. The system can operate over both local and Internet network systems. See col. 3:60-4:8. Walker explains the benefits allow players to play a variety of games from a remote location. See col. 1:19-34.

In view of Walker, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the either Thomas or the combination of Thomas with Tic-Tac-Dough to allow a

Art Unit: 3714

greater number of players to access games from remote locations over a network connection and thereby generate greater revenue for the operator.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703 308 4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 3590 for regular communications and 703 308 3579 for After Final communications.

Art Unit: 3714

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn  
April 18, 2002



MARK SAGER  
PRIMARY EXAMINER